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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,719	04/21/2000	Stephen G. Perlman	14531.27.2.3	6623

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EXAMINER

KOENIG, ANDREW Y

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,719

Applicant(s)

PERLMAN, STEPHEN G.

Examiner

Andrew Y Koenig

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-6, drawn to a recording system wherein the signal that reaches the system must be transmitted from the central device, classified in class 725, subclass 80.
- II. Claims 7-25, drawn to indexing and recording details, classified in class 386, subclass 95.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I, using the hub/spoke configurations has separate utility such as controlling, managing, processing, reformatting, and routing from a central device. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 2611

5. During a telephone conversation with Eric Kamerath on 23 June 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin et al. (Florin) in view of U.S. Patent 5,488,409 to Yuen et al. (Yuen).

Regarding claim 1, Florin teaches a transceiver (54) comprising three modules: the main module (62), and A/V connect module (66) and an optional compact disc read only memory module (70), see figures 1 and 2 (col. 8, ll. 37-40). The transceiver (54) of Florin equates to the claimed central device, which is directly connected to a television set (58) (claimed display device) through the A/V connect module (66) and to a VCR (56) (claimed recording system) (col. 8, ll. 52-12). Florin teaches the video signals and control signals being sent to the recording device (col. 8, ll. 57-61, col. 21-22, ll. 62-4). Florin teaches storing

Art Unit: 2611

program listings at the transceiver (col. 10, ll. 45-48). Florin teaches transmitting the programming to the VCR (col. 8, ll. 57-61). Florin is silent on transmitting the programming information included in the guide to the recording system and recording the programming information. Yuen teaches a VCR receiving programming information and recording the programming information (col. 30, ll. 25-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Florin by transmitting and recording programming information to the VCR as taught by Yuen in order to provide additional information on products and services offered in television programs or commercials (Yuen: col. 29, ll. 13-16). Florin teaches recording the signal at the recording system (col. 12, ll. 31-43).

Regarding claim 3, Florin is silent on the transceiver being an Internet terminal. Official Notice is taken that the user of an Internet terminal is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Florin by using an Internet terminal for the transceiver in order to enable the device to provide an additional source of information thereby enabling access to more information and services.

Regarding claim 4, Florin teaches connecting other devices to the A/V connect module and receiving a signal directly from the provider as shown in figure 1. Clearly, the system of Florin must receive the signal before the signal is transmitted from the central device.

Regarding claim 5, Florin is silent on recording an index of the relevant programming, wherein the information includes the location and information from

Art Unit: 2611

the program guide. Yuen teaches storing program information in the VBI of the signal wherein the information is used for a program guide (col. 12, ll. 44-51, col. 29, ll. 25-32, col. 30, ll. 25-65, fig. 34a, col. 46, ll. 3-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Florin by recording an index of the relevant programming, wherein the information includes the location and information from the program guide as taught by Yuen in order to facilitate access to the content on the tapes by using the index and locating the program thereby enabling the user to easily find programming.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin et al. (Florin) and U.S. Patent 5,488,409 to Yuen et al. (Yuen) in view of U.S. Patent 5,923,362 to Klosterman.

Regarding claim 2, Florin teaches connecting other devices to the A/V connect module and receiving a signal directly from the provider as shown in figure 1. However, Florin is silent on transmitting the signal from the electronics device to the central device (wherein "the signal" has antecedence to "a signal carrying programming" as recited in claim 1). Klosterman teaches various configurations of devices, in figure 1B, Klosterman teaches a coordinator receiving a plurality of sources and directing the appropriate signals to the output devices (col. 5, ll. 15-29). Accordingly, Klosterman teaches transmitting the signal from the electronics device to the central device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

Art Unit: 2611

to modify Florin by transmitting the signal from the electronics device to the central device as taught by Klosterman in order to enable the central device to receive signals from a plurality of sources, such as satellite and cable thereby facilitating the user in channel selections.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin et al. (Florin) and U.S. Patent 5,488,409 to Yuen et al. (Yuen) in view of U.S. Patent 5,761,371 to Ohno et al. (Ohno).

Regarding claim 6, Florin is silent on the title and frame number recorded on the tape. Yuen teaches encoding the title of the program and an absolute address in the VBI of the tape (col. 13, ll. 45-59, col. 30, ll. 25-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Florin by storing the title of the program on the tape as taught by Yuen in order to index the programming and providing additional information to the user. Florin and Yuen are silent on recording frame numbers. Ohno teaches storing the frame numbers in the VBI of a tape recording (col. 3-4, ll. 50-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Florin by storing the frame numbers as taught by Ohno in order to facilitate access to specific portions of the recording thereby enabling the user to view a selected portion of the tape.

Art Unit: 2611

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk



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